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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,419	06/18/2001	Takasi Oonuki	14714	9624

23389 7590 01/30/2006

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EXAMINER

NGUYEN, MINH CHAU

ART UNIT PAPER NUMBER

2145

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,419

Applicant(s)

OONUKI, TAKASI

Examiner

MINH-CHAU N. NGUYEN

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/18/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's response to requirement for restriction filed 10/31/05 has been fully considered. Therefore, claims 1 and 5 are presented for examination.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. As claims 1 and 5 are rejected to because of the following informalities: "a personal information storer configured to store identifying information for a recipient of an electronic mail sent by the user", or " storing identifying information for a recipient of an electronic mail sent by the user" is vague and unclear. It is not clearly understood then meaning of a provider (i.e. a personal information storer) stores a recipient's email, which is a recipient's identifying information, is sent by the user.  
  
Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (US 6,269,369 B1), and further in view of Katsikas (US 6868498 B1).

5. Regarding claim 1, Robertson teaches a personal information providing system for providing personal information regarding a user through the Internet, comprising:

a provider for providing the personal information regarding the user only to a requester with whom the user has communicated by electronic mail (i.e. a provider is the server, and a requester is the second user who wants to view the personal data of a first user (or the user). Moreover, a member A (first user) links to member B (second user) is notified in an email, thus A and B has communicated each other by email) (abstract; and Col. 1, L. 45-Col. 2, L. 26; and Col. 4, L. 27-45; and Col. 5, L. 5-64; and Col. 8, L. 10-Col. 9, L. 35).

Robertson fails to teach identifying information for a recipient of an electronic mail sent by the user to a personal information storer. Robertson only teach the personal information storer configured to store the identifying information for the recipient sent by the user (i.e. identifying information of recipient is equivalent to a name or email address of a second user; and a personal information storer is a database 340 in a central server 330) (abstract; and Col. 1, L. 45-Col. 2, L. 26; and Col. 4, L. 27-45; and Col. 5, L. 5-64; and Col. 8, L. 10-Col. 9, L. 35). However, Katsikas, in the same field of endeavor having closely related objectivity, teach identifying information for a recipient of an electronic mail sent by the user to a personal information storer (Col. 4, L. 37-55).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Katsikas's teachings of identifying information for a recipient of an electronic mail sent by the user to a personal information storer, in the teachings of Robertson in the networked personal contact manager, for the purpose of protecting the personal information of users by controlling the access of unknown requesters/recipients to the user's personal information.

6. Claim 5 is corresponding method claim of system claim 1. Therefore, it is rejected under the same rationale.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

- US 6,944,651 B2 Onyon et al. 09-2005
- US 2003/0023695 A1 Kobata et al. 01-2003

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (571)272-4242. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JASON D. CARDONE can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Minh-Chau Nguyen

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**JASON CARDONE**  
**SUPERVISORY PATENT EXAMINER**